

REMARKS

This responds to the Office Action mailed on July 12, 2004.

Claims 4-7, 17-19, and 22 are canceled by way of this amendment. No claims are amended or added. As a result, claims 8-16, 20, 21, and 23-27 are now pending in this application.

Amendments to the Drawing and Specification Made in the "Amendment & Response Under 37 C.F.R. 1.116" filed on April 8, 2004

Applicants assume that the proposed new FIGs. 7 and 8, and the proposed amendments to the specification, made in Applicants' "Amendment & Response Under 37 C.F.R. 1.116" filed on April 8, 2004, are deemed acceptable, because the Examiner did not indicate otherwise in the most recent Office Action.

Upon receipt of the Examiner's approval of new FIGs. 7 and 8, Applicants will submit replacement formal sheets.

Rejection of Claims 4-27 Under 35 U.S.C. §112, First Paragraph

Claims 4-27 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner asserted that the specification as originally filed fails to teach one skilled in the art certain limitations in claims 4, 17, and 22. The Examiner did not identify any other claims that allegedly fail to comply with the written description requirement.

In the interest of reducing the issues, Applicants have canceled claims 4, 17, and 22, and all claims dependent thereupon without prejudice.

Therefore, Applicants respectfully request that the rejection of claims 4-27 under 35 U.S.C. §112, first paragraph, be withdrawn.

Rejection of Claims 4-7
Under 35 U.S.C. §112, Second Paragraph

Claims 4-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention.

In the interest of reducing the issues, Applicants have canceled claims 4-7 without prejudice.

Therefore, Applicants respectfully assert that the rejection of claims 4-7 under 35 U.S.C. §112, second paragraph, is moot.

Rejection of Claims 4-8, 10-12, 14-15, 18-21 and 23-27 Under 35 U.S.C. §103(a)
as Unpatentable over Stevens in View of Ohashi and Parvulescu

Claims 4-8, 10-12, 14-15, 18-21 and 23-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stevens (U.S. 5,769,643) in view of Ohashi (U.S. 5,581,783) and Parvulescu (U.S. 5,724,410).

As mentioned above, Applicants have canceled claims 4-7 and 18-19 without prejudice.

Applicants will discuss below the patentability of independent claims 8, 12, and 23 over the asserted combination of Stevens, Ohashi, and Parvulescu, but first Applicants will briefly summarize the subject matter disclosed in these three references. In addition, Applicants will point out where these references differ significantly Applicants' pending claims.

Stevens discloses an instruction communication network having a first computer 12, which may be operated by a student, and a second computer 14 operated by a teacher. The first and second computers may be in wireless communication with each other (col. 2, lines 53-55). In one embodiment, the first computer 12 may be a personal digital assistant ("PDA") (see col. 3, lines 34-39) having a display 56, stylus 55, microphone 67, and sound circuitry 65.

Regarding independent claim 8, it is noted that Stevens fails to disclose a PC having speech-recognition software. Also, Stevens' display (56, FIG. 3) fails to display "translated voice data" that has been translated by the speech-recognition software from "electronic voice signals" received by the PC from the stylus.

Ohashi discloses a multimedia information capturing system comprising a stylus 1 (FIG. 6a) having a microphone 71, a wireless transmitter 18, and a wireless receiver 75. The system additionally includes an associated "data processing unit" 3 (FIG. 6b) that has a wireless transmitter 83, a wireless receiver 32, a voice-reproducing unit 83, and a speaker 84. Voice information captured with the stylus can be reproduced in the data processing unit's speaker 84. It will be noted that in Ohashi the term "voice data" is used to describe recorded acoustic voice signals, as opposed to "translated voice data" or "translated voice information" as recited in Applicants' claims 8-9, 12-14, 16, and 23.

Parvulescu discloses a voice-messaging system in which a voice-message transmitting terminal 20 (FIG. 1) first converts a voice message to digitized text, and then sends it to a receiving terminal 70 (FIG. 2). The receiving terminal 70 can display the digitized text if such receiving terminal 70 is incapable of audibly reproducing the voice message.

Regarding independent claim 8, it is noted that Parvulescu's voice-messaging terminal 20 transmits only converted speech (i.e., "translated voice data", using Applicants' terminology) rather than unconverted "electronic voice signals". In independent claim 8, for example, the "electronic voice signals" are clearly unconverted, because claim 8 recites "speech recognition software to instruct the processor to translate electronic voice signals into translated voice data".

Regarding the rejection of independent claims 8, 12, and 23, Applicants respectfully assert that a *prima facie* case of obviousness has not been established, and that the suggested combination of Stevens in view of Ohashi and Parvulescu is based upon hindsight and would not have been suggested but for Applicants' own disclosure.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The MPEP §2142 contains explicit directions to the Examiner in consonance with the *In re Fine* holding:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (Citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Regarding independent claim 8, a *prima facie* case of obviousness is not established, because the references, even when combined as the Examiner suggests, fail to disclose all of the recited elements. None of the cited references discloses a PDA having a touch screen display to display translated voice data. Neither Stevens nor Ohashi even mention "translated voice data" or speech-to-text conversion. Parvulescu performs speech-to-text conversion in a voice-message transmitting terminal (FIG. 1) and sends the converted data (i.e. "translated voice data") to a receiving terminal, where it may either be displayed (FIG. 6) or played back audibly (FIG. 7). However, regarding independent claim 8, the receiving terminal fails to "receive electronic voice signals from a stylus".

Regarding independent claim 12, a *prima facie* case of obviousness is not established, because the references, even when combined as the Examiner suggests, fail to disclose all of the recited elements. The combination of references fails to disclose detecting speech with a microphone in a hand-held stylus and outputting electronic voice signals (the only reference that may be said to disclose detecting speech with a microphone in a hand-held stylus is Ohashi); transmitting the electronic voice signals to a PDA (Ohashi may be said to disclose this too); and translating the electronic voice signals into translated voice data and storing the translated voice data in the PDA (Ohashi fails to disclose any speech-to-text conversion whatsoever, and Parvulescu only performs its speech-to-text conversion in the voice-message transmitting terminal (i.e. the "transmitting" element), not in the receiving terminal, so these references cannot be combined to teach or make obvious "translating the electronic voice signals into translated voice data and storing the translated voice data in the PDA".

Regarding independent claim 23, a *prima facie* case of obviousness is not established, because the references, even when combined as the Examiner suggests, fail to disclose all of the recited elements. For example, the three references, whether taken individually or in combination, completely fail to disclose certain of the recited operations. For example,

regarding the third operation (“the PC performing voice recognition processing on the electronic voice signals to produce translated data”), Stevens and Ohashi fail to disclose any “voice recognition processing” whatsoever, and Parvulescu only performs its “voice recognition processing” in a voice-messaging terminal, i.e. the device that initially transmits the “electronic signals”. Parvulescu fails to disclose a PC “performing voice recognition processing on the electronic voice signals to produce translated data” or the PC “wirelessly transmitting the translated data to the PDA”. Nor does Parvulescu disclose either of the remaining two limitations in independent claim 23.

In summary, even if the Stevens, Ohashi, and Parvulescu references were to be combined as suggested by the Examiner, they fail to make a *prima facie* case of obviousness, because they fail to teach or suggest all the claim limitations.

It is therefore respectfully requested that the rejection of independent claims 8, 12, and 23 under 35 U.S.C. §103(a) as being unpatentable over Stevens in view of Ohashi and Parvulescu be withdrawn.

Dependent claims 10, 11, 14, 15, 20, 21, and 24-27, which depend from their respective independent claims, directly or indirectly, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

**Rejection of Claims 9, 13, 16-17 and 22 Under 35 U.S.C. §103(a)
as Unpatentable over Ohashi in View of Stevens and Parvulescu**

Claims 9, 13, 16-17 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohashi in view of Stevens and Parvulescu.

As mentioned above, Applicants have canceled claims 17 and 22 without prejudice.

Claims 9 and 13 are dependent upon independent claims 8 and 12, respectively, which are asserted to be patentable over the Ohashi, Stevens, and Parvulescu references for the reasons set forth above. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. MPEP §2143.03.

Regarding independent claim 16, a *prima facie* case of obviousness is not established, because the references, even when combined as the Examiner suggests, fail to disclose all of the

recited elements. Again, Ohashi is the only reference that may be said to disclose the first two recited operations. However, regarding the third-recited operation (“the PC performing voice recognition processing”), Ohashi fails to disclose any speech-to-text conversion whatsoever, and Parvulescu only performs its speech-to-text conversion in the voice-messaging terminal (i.e. the “transmitting” element), not in the receiving terminal (which moreover is not disclosed by Parvulescu to be a PC), so these references cannot be combined to teach or make obvious “the PC performing voice recognition processing”. Nor do any of the three references disclose the fourth operation (“the PC wirelessly transmitting the translated data to a PDA”), because Stevens and Ohashi fail to disclose any “translated data” (i.e. speech-to-text converted data), and because Parvulescu fails to disclose a PC wirelessly transmitting data to a PDA.

It is therefore respectfully requested that the rejection of independent claim 16 under 35 U.S.C. §103(a) as being unpatentable over Ohashi in view of Stevens and Parvulescu be withdrawn.

Dependent claims 9, 13, 17, and 22, which depend from their respective independent claims, directly or indirectly, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Conclusion

Applicants respectfully submit that claims 8-16, 20, 21, and 23-27 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants’ attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/211,942

Filing Date: December 15, 1998

Title: POINTING DEVICE WITH INTEGRATED AUDIO INPUT

Assignee: Intel Corporation

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Dkt: 884.078US1 (INTEL)

If necessary, please charge any additional fees or credit overpayment to Deposit Account
No. 19-0743.

Respectfully submitted,

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Date Oct. 12, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12th day of October, 2004.

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Signature